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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,381	09/02/2004	Yves Auberson	PN/4-32343A	1643
75/074 75/90 05/30/2008 NOVARTIS INSTITUTES FOR BIOMEDICAL RESEARCH, INC. 400 TECHNOLOGY SQUARE CAMBRIDGE, MA 02139				
EXAMINER				
SACKEY, EBENEZER O				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
05/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/506,381

Applicant(s)

AUBERSON, YVES

Examiner

EBENEZER SACKEY

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 7-27, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 09/02/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 1-27 and 29-30 are pending.

This is in response to applicant's amendment filed on 11/02/07.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed on 09/02/04 is acknowledged and has been entered into the file. A signed copy of the 1449 is attached herewith.

Response to Restriction

Applicant's election of Group I claims 1-6 in the reply filed on 11/02/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

With regard to applicants comment about claim 6, according to 371 Rules, applicants are entitled to one method of use claim. Thus, the inclusion of claim 6 into Group I.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is depending on claim 1 for the definitions of the substituents. Such is not permitted since claim 1 (a compound claim) and claim 2 (a process claim) falls into separate statutory claim of invention. Correction is required.

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

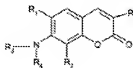
2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application
indicating obviousness or nonobviousness.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkawa et al., (U.S. Patent number 3,933,847) or Schafer et al., (U.S. Patent number 4,035,740) or Hausermann et al., (U.S. Patent number 3,014,041) each taken alone.

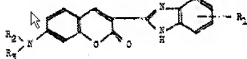
Applicant claims coumarin compounds of structural formula (I), wherein the substituents



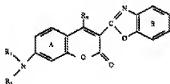
are as defined in formula (I)

Determination of the scope and content of the prior art (MPEP §2141.01)

Ohkawa et al., teach compounds similar to formula (I), with similar substituents. See the entire reference, especially column 1, lines 15-20, column 2, lines 20-25, column 3, lines 1-40 where R is benzimidazolyl, each of R₁ and R₂ is hydrogen and each of R₃ and R₄ is methyl. Note Table 1 which teaches compounds within the generic formula (I)



Schafer et al., teach benzoxazolyl compounds similar to formula (I), with similar substituents. See the entire disclosure especially column 2, lines 1-10, column 3, lines 36-45, Example 1 in column 4 and various compounds taught in columns 5 and 6



Hausermann et al., teach various benzimidazolyl compounds similar to formula (I). See the entire reference especially column 6, lines 32-33 and column 7 and 8 where various species such as 3-(benzimidazolyl-2')-aminocoumarin is disclosed. It is noted

that applicants have excluded species from Hausermann et al. Thus, the exclusion may serve to differentiate the compounds from under 35 U.S.C. 102, but does not serve to remove the relied upon reference from under 35 U.S.C. 103.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Thus, the various references differ from the current invention in that the references teach compounds and composition within generic formula (I). However, the selection of "some among many" is *prima facie obvious*. Note the intended use of the current compounds (claim 6) do not carry any patentable weight. Note Ohkawa et al., discloses processes of preparing the compounds of structural formula (I). See column 2, lines 1-50 for the preparation of other derivatives of formula (I).

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2143)

Accordingly, one of ordinary skill in the art would thus have been motivated to pick and choose the particular combination of Markush elements as suggested by the references examples of structurally similar compounds. Hence, the selection of some among many is *prima facie obvious*, absent a showing of unexpected properties and results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Art Unit: 1624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**